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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,814	03/26/2004	Suman Preet Singh Khanuja	US 1374/04	8540

EXAMINER	
CALAMITA, HEATHER	

ART UNIT	PAPER NUMBER
1637	

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Law Office - Dinesh Agarwal, P.C.
Suite 330
5350 Shawnee Road
Alexandria, VA 22312

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,814

Applicant(s)

KHANUJA ET AL.

Examiner

Heather G. Calamita, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 3-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application, Amendments, and/or Claims

1. Claims 1-12 are currently pending. Claims 3-9 are withdrawn as being directed to non-elected subject matter. Claims 1, 2 and 10-12 are under examination. All arguments have been fully considered and thoroughly reviewed, but are deemed not persuasive for the reasons that follow. Any objections and rejections not reiterated below are hereby withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida et al. (Mol Gen Genet., 1988).

With regard to claim 1, Yoshida et al. teach an oligonucleotide as alpha-arteether resistance domain comprising SEQ ID NO: 1 (see p. 4 and the alignment below).

With regard to claim 2, Yoshida et al. teach an oligonucleotide as alpha-arteether resistance domain of SEQ ID NO:1 wherein the domain is from 241-261 nucleotide position of gyrA gene from translation start site of *E. coli* (see p. 4 and the alignment below).

SEQ ID NO:1 1 GGTGACTCGGCGGTCTATGAC 21

Yoshida et al 424 GGTGACTCGGCGGTCTATGAC 444

With regard to claims 10-12, Yoshida et al. teach SEQ ID NOs 3 and 4 (see p. 4 and the alignment below).

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SEQ ID NO: 3 1 AATTTGCGACCTTTGAATCCG 21

Yoshida et al. 137 AATTTGCGACCTTTGAATCCG 157

SEQ ID NO : 4 1 CTGGGTCTGGGAGTAGAGGTTG 22

Yoshida et al. 1158 CTGGGTCTGGGAGTAGAGGTTG 1137

With regard to the rejections of claims 1, 2 and 10-12 over Yoshida, Yoshida do not specifically teach an alpha-arteether domain, however Yoshida does teach the nucleotide sequences comprising SEQ ID NOs 1, 3 and 4 respectively. According to *In re Best* 195 USPQ 430, 1997, the court stated that, "Patent Office can require applicant to prove that prior art products do not necessarily or inherently possess characteristics of his claimed product wherein claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicant" (pp. 430). Therefore, Yoshida et al. anticipate the invention as claimed.

Response to Arguments

3. Applicants' arguments filed August 3, 2007, have been fully considered but they are not persuasive. Applicants argue the instant claims are drawn to a domain of the gyrase gene responsible for conferring alpha arteether resistance and Yoshida teach a region of the gyrase gene responsible for quinolone resistance. This argument is non persuasive because the instant claims are drawn to a product. The claims are drawn to the oligonucleotide of SEQ ID NO: 1. The claim is interpreted as using open language and Yoshida teaches the SEQ ID NO: 1 as detailed in the rejection and alignment above. The recitation of "as alpha-arteether resistance" imparts no structural limitation to the oligonucleotide. Additionally, MPEP 2112.01 states, "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). Because Yoshida et al. teach an oligonucleotide

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comprising SEQ ID NO: 1, the oligonucleotide of Yoshida et al. necessarily has the same characteristics as the instantly claimed oligonucleotide. Applicants make arguments regarding a variety of mutations. This argument is irrelevant as no mutations are claimed. For all of the reasons outlined above, the rejections are maintained.

Summary

4. No claims were allowed.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather G. Calamita whose telephone number is 571.272.2876 and whose e-mail address is heather.calamita@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner can normally be reached on Monday through Thursday, 7:00 AM to 5:30 PM.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at 571.272.0782.

Papers related to this application may be faxed to Group 1637 via the PTO Fax Center using the fax number 571.273.8300.

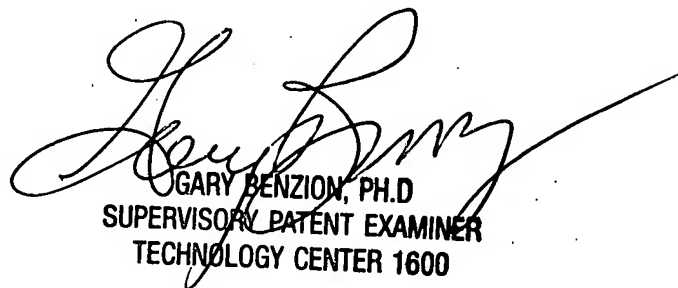
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 571.272.0547.

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